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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,086	10/29/2001	Nathaniel T. Becker	GC644-3	8483

5100 7590 05/04/2005

GENENCOR INTERNATIONAL, INC.
ATTENTION: LEGAL DEPARTMENT
925 PAGE MILL ROAD
PALO ALTO, CA 94304

EXAMINER

KUMAR, PREETI

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/033,086

Applicant(s)

BECKER ET AL.

Examiner

Preeti Kumar

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: 28.
Claim(s) rejected: 1,2,6,7,9-19,28,30-32 and 34-42.
Claim(s) withdrawn from consideration: 3-5, 8, 20-27, 29, and 33.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Advisory

1. Claims 1,2,6,7,9-19,28,30-32 and 34-42 are pending.
2. The Amendment After Final submitted on March 8, 2005 will not be entered for the reasons given in the summary page of the Advisory Action. The amendment filed March 8, 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants have incorporated by reference the teachings of US 1991000642596 and US 1991000419391 in the specification. This constitutes new matter since applicants have not addressed whether these 2 documents are related to any of the other documents incorporated by reference.

Also, the amendment to claim 28 reciting an enzyme particle for compositions raises 35 U.S.C. 112, second paragraph, indefinite issues since the claim as presented does not make clear or define the boundaries of the subject matter for which patent protection is sought.

Furthermore, applicants have not provided any additional data or showing of unexpected or unobvious results to overcome the rejection of record as recited in the final rejection, dated 1/12/1005.

Response to Arguments

3. Applicant's arguments filed March 8, 3005 have been fully considered but they are not persuasive. Applicant's argument that Herrmann et al do not teach the same enzyme does not comply with 37 CFR 1.111(c) because they do not clearly point out

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the patentable novelty which s/he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Specifically applicants state that the enzyme taught by the prior art is different from that which is claimed. Examiner does not see how the enzyme granulates containing a cellulase, lipase, catalase, oxidase, peroxidase, thermostable .alpha.-amylase or a protease as taught by Herrmann et al. is different from the enzyme component claimed. Furthermore applicants have failed to address how the catalase enzymes of the genus *Aspergillus*, *Ascomycetes*, *Streptomyces*, *Humicola*, or *Micrococcus* as taught by Herrmann et al. is different from the catalase enzymes recited by the instant claims.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Specifically the September 1993 Research Disclosure, RD 35346A, teaches a method for producing an enzyme containing particle with a core and an enzyme containing shell. The core materials include sucrose, kaolin, potato starch. The enzymes may be selected from proteases, amylases, and lipases. See RD 35346 first paragraph. In paragraph 3, RD 35346 discloses the advantageous utility of catalase from *Aspergillus niger*. Also, in paragraph 2, the utility of peroxidase in the enzyme core

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is also disclosed. The disclosure RD 35346 illustrates an example where 780 g of catalase concentrate with a dry matter content of 14.3% is sprayed onto the surface of the sucrose core material to formulate an active, stable enzyme granulate. See paragraph 4. The teachings of RD 35346A were within the level of ordinary skill at the time the claimed invention was made and thus the rejection is not made with knowledge gleaned only from the applicant's disclosure.

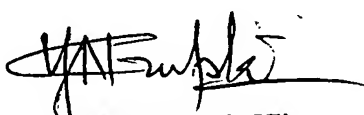
Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PK


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Preeti Kumar
Examiner
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